Claims 37-55 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending application Serial No. 09/114,795, which has now matured into U.S. Patent No. 6,319,353. In response, there is submitted a terminal disclaimer relative to the patent.

Claims 37-50 and 3-54 were rejected under 35 USC §103(a) as being obvious over Wendler et al. ("Wendler"), U.S. Patent No. 3,660,347, or Matsui et al. ("Matsui"), U.S. Patent No. 5,810,960, each in view of either Davis, U. S. Patent No. 3,208,982, or Lipman, U.S. Patent No. 3,631,008.

Claims 51-52 were rejected under 35 USC §103(a) as being obvious over Wendler or Matsui each in view of either Davis or Lipman, and each further in view of the Japanese Dobashi reference, JP 6-212135.

Claim 55 was rejected under 35 USC §103(a) as being obvious over Wendler or Matsui each in view of either Davis or Lipman, and each further in view of the Japanese Toppan reference, JP-59-122570.

In response to *all three* rejections, Applicants previously argued that the instant claims

required that the adhesive composition comprise a copolymer of at least two different C_{2-12} α-olefins and a diene, but not "75 mol-% or more of any single α-olefins," and that the Examiner had not made out a *prima facie* case that this limitation would have been obvious from the cited combination of references.

Applicants then discussed the data in the instant specification, which Applicants submitted showed the criticality of the "less than 75 mol %" limitation *in the context of the present method.* Thus, it was shown that when one operated *inside* the claimed range (Inventive Examples 1-4), no defects were seen as a result of the bonding of the adhesive to paint. In contrast, it was also shown that when one operated *outside* the claimed range (Comparison Examples 1-5), then either there were bond deformations of the paint (Comparative Examples 1 and 3-5) or the adhesive did not bond sufficiently (Comparative Example 2). Thus, these data proved the criticality of operating inside the "less than75 mol-%" limitation when practicing the claimed method.

The question then becomes whether there is anything in the cited combination of references to suggest this result. The Examiner's only comment at the bottom of page 4 and top of page 5 of the final rejection is that Davis teaches the "less than 75 mol-%" limitation.

Even were this true, Applicants point out that Davis *does <u>not</u> teach the instant method.*

Thus, the Examiner has relied on Wendler and Matsui to teach the instant method, and on Davis or Lipman to teach adhesive compositions allegedly useful in that method.

However, there is nothing in any of the cited references that suggests that Davis' adhesive would have been any better suited for Wendler's and Matsui's method than other structurally similar adhesive compositions, for example, the adhesive compositions of the instant comparative examples. Accordingly, when persons skilled in the art selected Davis' adhesive to use in Wendler's and Matsui's method, they would have done so without any expectation of achieving any better result than with any other adhesive.

In short, even if it is true that Davis discloses adhesive compositions useful in the present method, that fact does not foreclose the possibility that the present method is unobvious upon the present showing of unexpected results. Applicants have *not* claimed to made *an adhesive invention,* but, rather, to have made *an invention of the selection of particular adhesives to use in the present method.* That invention is proven by the showing that Applicants have discovered that particular selections of the adhesive components within the claimed ranges have an unexpected beneficial effect on the results. Since there is nothing in the cited combination of references that suggests a selection of the adhesive component along the lines presently claimed should have had any effect whatsoever on the results achieved, the data, which shows the proper selection *does* make a difference, must be regarded as surprising and unexpected, and, therefore,

as objective evidence of nonobviousness.

Finally, Applicants emphasize that the data in the Table on page 4 of the amendment dated August 21, 2001, is a *compilation of data in the specification*. Since the Examiner indicates under point (b) on page 5 of the final rejection that "data presented in the specification takes precedence over any data which may be presented in a Declaration or affidavit," Applicants respectfully request that the Examiner reconsider the data and its importance.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the attached Mark-Up Showing the Changes Made in the Specification and the accompanying Terminal Disclaimer (8 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: November 29, 2002

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Kurt G. Briscoe

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MARK-UP SHOWING THE CHANGES MADE IN THE SPECIFICATION

Page 19 , line 1

What is Claimed is: